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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,739	04/06/2001	Jim Reich	540606-2001	9745
20999	7590	09/28/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			BOYD, JENNIFER A	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 09/28/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/837,739

Applicant(s)

REICH, JIM

Examiner

Jennifer A Boyd

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15 - 17, 19 - 21, 23 - 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-17, 19-21, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/20/04</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

1. The Applicant's Amendments and Accompanying Remarks, filed June 28, 2004, have been entered and have been carefully considered. Claims 15 – 24 are pending. In view of Applicant's arguments, the Examiner withdraws the 35 U.S.C. 103(a) rejection of claims 20 – 21 and 24 as being unpatentable over Gurian (US 5,856,005) in view of Robinson (US 2002/0069904) as detailed in paragraph 4 of the previous Office Action dated January 27, 2004. The invention as currently claimed is not found to be patentable for reasons herein below.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 102***

3. Claims 15 – 17, 19 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Gurian (US 5,856,005). The details of the rejection can be found in paragraph 3 of the previous Office Action dated January 27, 2004. The rejection is maintained.

***Claim Rejections - 35 USC § 103***

4. Claims 15 – 16, 19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke (US 6,258,455). The details of the rejection can be found in paragraph 5 of the previous Office Action dated January 27, 2004. The rejection is maintained.

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5. Claims 20 – 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke (US 6,258,455) in view of Newman (US 6,000,057). The details of the rejection can be found in paragraph 6 of the previous Office Action dated January 27, 2004. The rejection is maintained.

### ***Response to Arguments***

6. Applicant's arguments filed June 28, 2004 have been fully considered but they are not persuasive.

7. In response to Applicant's argument that Gurian fails to disclose that the fabric can be an odor-reducing fabric, the Examiner admits Gurian does not specifically disclose such a function for the fabric. However, it should be noted that Gurian meets all claimed structural and/or chemical limitations. It has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Gurian in view of Robinson discloses a woven or knitted fabric comprising polyester and acetate comprising MICROBAN, wherein the acetate fiber is present at least 25% by weight of the fabric, and the polyester and acetate fibers are entwined by means of air entanglement. It should be noted that there is nothing on record that demonstrates that the odor-reducing material of Gurian in view of Robinson cannot be used to create an odor-reducing hunting garment. Additionally, since Gurian meets all claimed structural and/or chemical limitations, it is asserted that the "odor-reducing" property must be inherent to the Gurian product. If said "odor reducing" property is not inherent, it is asserted that Applicant's claim must be incomplete. In other words,

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if Applicant's asserts a lack of inherency in the Gurian product, then Applicant's claimed invention is missing an element that is critical to the invention, which would patentably distinguish it from the known prior art.

8. In response to Applicant's argument that the instant invention is drawn to an odor-reducing fabric only, the Examiner acknowledges the fact, however, the Applicant does not claim that the fabric cannot also function as an anti-microbial fabric. Additionally, the Applicant does not claim that the fabric has to have a certain level of odor-reducing capabilities, only that it possesses some level of capability. Because Gurian discloses all physical and/or chemical limitations of the **claimed** invention, it is the position of the Examiner that the fabric of Gurian will exhibit some level of odor-reducing capability. If the Applicant desires that the fabric have a certain level of odor reducing capacity, it is highly suggested that the Applicant claim numerical target value of a parameter such as odor intensity as adsorbent concentration in parts-per-million (see Applicant's specification, page 18).

9. In response to Applicant's argument that the examples in Gurian only provide for a fabric comprising 6% anti-microbial acetate and a fabric comprising 9% anti-microbial acetate and, therefore, the patent only provides support for such percentages, the Examiner respectfully argues the contrary. Gurian teaches a yarn with base filaments formed of a plurality of the permanently flame-retardant filaments and a pair of effect filaments – one of the plurality of permanently flame-retardant filaments and one of the plurality of permanently anti-microbial filaments (column 3, lines 23 – 45). Gurian teaches that the yarn can be incorporated into a knitted or woven fabric (column 4, lines 53 – 60). Gurian teaches that the fabric comprises at least 5% by weight of the anti-microbial filaments (column 4, lines 60 – 65). It should be noted

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that the phrase “at least 5% by weight” encompasses the Applicant’s range of “at least 25% by weight”. It should be noted that in that statement Gurian provides **no upper limit** for the weight percentage of anti-microbial filaments in the fabric. Although the examples only suggest using 6% in one example and 9% in another example, they should be only treated as examples. It would be improper to ignore the complete disclosure of the patent.

10. In response to Applicant’s argument that an increase in the percent by weight of the acetate in the fabric of Gurian, i.e., up to 25% by weight, would likely lead to the loss of flame-retardant properties of the fabric, the Examiner respectfully argues the contrary. First, the idea of loss of flame-retardancy is mere conjecture on the part of the Applicant. In order to provide sufficient evidence that the inclusion of up to 25% will in fact reduce the flame-retardant properties of the fabric of Gurian, the burden is upon the Applicant to submit a 37 CFR 1.132 Declaration to support Applicant’s assertion. In the Declaration, the Applicant should compare a sufficient number of tests to demonstrate that the fabric of Gurian would have significantly reduced flame-retardant properties at higher acetate levels or, alternatively, that the fabric of Gurian could not function as Applicant’s odor-reducing garment by means of physical evidence.

11. In response to Applicant’s argument that DesignTex does not manufacture or sell a flame-resistant and anti-microbial fabric that contains more than 11% acetate, the Examiner respectfully requests that the Applicant submit a 37 CFR 1.132 Declaration to support Applicant’s assertion. Additionally, it is not the role of the patent office to question the validity of a patent. Gurian positively states teaches that the fabric comprises **at least 5% by weight** of the anti-microbial filaments (column 4, lines 60 – 65). Although DesignTex might not sell flame-

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resistant and anti-microbial fabric having a content more than 11%, it does not suggest that the patent to DesignTex did not intend to claim at least 5% by weight with no upper bound.

12. In response to Applicant's argument that Clarke is directed towards the use of microfibers while the present invention does not utilize microfibers, the Examiner respectfully argues that the fiber size is irrelevant. The Examiner acknowledges that microfibers are quite different in size and also characteristics when compared to fibers of a larger size. However, the Applicant does not claim a certain fiber size in the claims. Therefore, the cloth containing microfibers of Clarke would read on the claim as currently drafted because it meets all **claimed** limitations. If the Applicant requires that the fabric of the present invention cannot contain microfibers, the Applicant should put limitations in the claims to requiring a certain denier size or requiring that the fibers cannot be microfibers.

13. In response to applicant's argument that Clarke and Newman are nonanalogous art and, therefore, there would be no suggestion to combine the references, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Clarke is directed to an antimicrobial cloth that is suitable for a variety of applications includes mops, dishcloths, towels, wiping clothes, diapers, sanitary napkins and other feminine hygiene products, bed sheets, pillow cases and the like (Title and column 4, lines 63 – 68). Newman is directed to an odor-preventing hunting apparel comprising an antimicrobial fabric (Abstract). Clarke is suitable for a variety of applications and

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comprises antimicrobial fibers, therefore, it would be obvious and suggested that it could be used in an application such as Newman.

14. In response to Applicant's argument that the fabric of the present invention is more successful at reducing odor than the Contain<sup>TM</sup> used in Newman, the Examiner respectfully argues that the data is irrelevant. The Applicant does not claim superior odor-reducing properties than a traditional odor-reducing fabric nor does the Applicant claim a required level of odor-reducing capability. Furthermore, it is highly suggested to the Applicant in order to give full weight to Applicant's data, it is requested that the Applicant to submit the data in 37 CFR 1.132 Declaration form.

### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

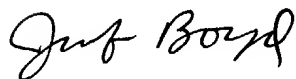


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A Boyd whose telephone number is 571-272-1473. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jennifer Boyd  
September 14, 2004



**Ula C. Ruddock**  
Primary Examiner  
Tech Center 1700